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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,687	02/25/2000	Yong-Hoon Lee	1316.1041/MDS	7481
21171	7590	07/12/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			FERGUSON, LAWRENCE D	
		ART UNIT	PAPER NUMBER	
			1774	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/513,687	LEE ET AL.
	Examiner	Art Unit
	Lawrence D Ferguson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***DETAILED ACTION***

***Response to Amendment***

1. This action is in response to the request for reconsideration mailed April 14, 2004. Claims 1-38 are pending, with claims 31-38 withdrawn as a non-elected invention.

***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (U.S. 5,470,627) in view of Strandjord et al. (U.S. 5,016,240).

Lee discloses a double-sided optical storage disk comprising a substrate having a microstructure formed on each side surface, where the microstructure is in the form of grooves (abstract) where grooves are analogous to track guides. Lee discloses, formed on each of the side surfaces from the substrate outward are a reflective layer, dielectric layer, recording layer and transparent protective layer (column 4, lines 27-34). Lee shows hills of a peaked hood shape in figure 4. Lee additionally shows embossed microstructures of one side of the substrate protruding towards the protective layer of the second side of the substrate and narrows towards the protective layer in Figure 4, as amended in instant claim 1. Although Lee does not explicitly disclose the height of

the peaked hood shape or grooves or the thickness of the protective layer, height and thickness are optimizable. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering the optimum or workable values involves only routine skill in the art. Although Lee does not show the second micro-embossments protruding toward the second protective layer, as in instant claim 7, it would have been obvious to one of ordinary skill in the art to reverse the embossments of Lee as depicted in Applicant's instant Figure 3, because a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Lee does not explicitly disclose micro-embossments protruding from the substrate.

Strandjord teaches an optical disc comprising small protrusions from a substrate, where the substrate is further coated by a reflective material (column 1, lines 50-54 and column 2, lines 20-35). Lee and Strandjord are analogous art because they are from the field of optical discs. It would have been obvious to one of ordinary skill in the art to include small protrusions (micro-embossments) on the substrate of Lee because Strandjord teaches the small protrusions improve the coding of information signals (column 1, lines 55-63).

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohta et al (U.S. 5,425,008) teaches an optical disk comprising protrusions formed on the transparent substrate between the recording track and guide track (column 5, lines 40-58).

***Response to Arguments***

5. Remarks in regard to the rejection under 35 USC 103(a) as being unpatentable over Lee et al. (U.S. 5,470,627) in view of Vedamuttu (U.S. 6,165,391) have been considered and Vedamuttu is withdrawn due to the secondary reference not teaching the substrate having micro embossments or protrusions. Lee et al. is maintained for reasons of record and is combined with Strandjord et al. to teach an optical disc comprising small protrusions from a substrate (column 1, lines 50-54 and column 2, lines 20-35).

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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